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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/714,987	09/17/1996	HUGH SHARKEY	14170-014001/PT-2537-USNP	4099
26166 7590 01/15/2009 FISH & RICHARDSON P.C. SMITH & NEPHEW, INC. 150 Minuteman Road Andover, MA 01810				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3769				
MAIL DATE		DELIVERY MODE		
01/15/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 08/714,987	<b>Applicant(s)</b> SHARKEY ET AL.
<b>Examiner</b> david shay	<b>Art Unit</b> 3769

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED December 17, 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/david shay/  
Primary Examiner, Art Unit 3769

Continuation of 11, does NOT place the application in condition for allowance because: Applicant asserts that the statement of Kirwin that "these areas should not overlap. In fact it is better to leave a small margin of untouched tissue about each one" constitutes a teaching away by Kirwin of providing adjacent or overlapping treatment areas. The examiner must respectfully disagree. The use of the term "should" rather than "must" in the quoted statement clearly shows that the provision of overlapping or adjacent treatment areas is merely a less preferred embodiment of the method of Kirwin, compared to the preferred embodiment of providing a small margin. Further, the teaching of Roth et al show the use of a technique where linear treatment areas, which overlap and/or are directly adjacent is a recognized treatment pattern in the art for reducing the bulk of the prostate in men experiencing BPH. In performing a method as taught by Roth et al using the energy of Kirwin, or performing the method of Kirwin using the treatment pattern of Roth et al would result in the claimed back and forth motion, and the inclusion of a temperature sensor would inherently provide the claimed temperature sensing, particularly when the applicator is extended to its distal position prior to being rotated into the next treatment position, which would be the expected procedure, since both Kirwin and Roth et al emphasize the importance of temperature control in their procedures. Both Kirwin and Roth also discuss that it is the energy that is applied to the tissue that is of paramount importance, and thus one of ordinary skill in the art would understand that the energy could be varied in the method of Roth to allow for tissue contact as in the method of Kirwin, thus this argument is not convincing. Respecting applicant's assertion that the examiner has taken official notice regarding the production of linear lesions, the examiner must respectfully point out that the statement referred to is merely a summary of teachings found in Roth et al and Swanson et al. With regard to the arguments regarding the Sand reference, particularly with respect to claims 107 and 112, the examiner notes that the contacting of a joint is obvious in view of the teaching of Sand to treat connective tissues involving joints (e.g. ligaments and tendons), further especially when treating joints or connections between muscles and bones or bones and bones, the provision of an under treatment, rather than an overtreatment is clearly warranted, since an undertreatment (insufficient shrinkage) would simply result in a joint which is still too loose and which can easily be remedied by further treatment, which further treatment can proceed in view of the knowledge gained by the observation of the reaction of the tissue to the first treatment, and thus be more likely to approach the ideal desired joint tightness or stability, while overtreatment will result in a joint which has too much shrinkage and will no longer have the original mobility. Therefore, given the fact that one of ordinary skill in the art is an orthopedic surgeon requiring not only 12 years of primary and secondary school, but 4 years of college, 4 more years of medical school, and additional years as an intern before qualifying to perform such surgeries, the ramifications of overtreatment and the advantage of approaching the desired degree of shrinkage from the direction of initial under treatment, rather than over treatment would not be lost on one of ordinary skill in the art. Lastly, regarding applicant's assertion of unexpected result, the examiner is at a loss to understand how one of ordinary skill in the art, especially one of ordinary skill in the art as set forth in the preceding sentence, would find the movement of a temperature sensing device toward an area which still contained residual heat to register a greater temperature than if it were moved away from such a site an "unexpected result". Thus this argument is also not convincing.